

07-24-06

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Attorney's Docket No. 043455/274252

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/802,367 Confirmation No.: 8322
Appellant(s): Michael Last
Filed: March 9, 2001
Art Unit: 2629
Examiner: MOONEYHAM, JANICE A.
Title: SYSTEM AND METHOD FOR POSTING AVAILABLE TIME
SLOTS TO A NETWORK HUB

Docket No.: 043455/274252
Customer No.: 00826

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.181(a)

This Petition is filed in response to the Examiner's Answer mailed on May 23, 2006 pursuant to 37 CFR § 1.181(a). The Commissioner is hereby authorized to charge the Deposit Account No. 16-0605 for \$130 as required under 37 C.F.R. § 37 CFR 1.17.

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REMARKS

1. Point to be Reviewed

This Petition is filed in response to the Examiner's Answer mailed on May 23, 2006, to address the Examiner's failure to comply with the requirements for entering new grounds of rejection.

2. Statement of Facts

Appellant filed this application for patent on March 9, 2001. After a lengthy prosecution, this appeal was filed. The relevant communications are addressed chronologically.

In the Office action dated November 17, 2004, the Examiner issued a final rejection of the claims pending in the application. In response to this rejection, on February 17, 2005, Appellant filed a Request for Continued Examination, cancelled all claims pending in the application at that time (Claims 1-60), added new claims (Claims 61-70), and provided substantial, objective evidence of nonobviousness. In the subsequent Office action dated March 24, 2005, the Examiner issued a new section 102 rejection and failed to address the merit of Appellant's objective evidence of nonobviousness. Appellant responded to the Office action of March 24, 2005, in the communication dated June 24, 2005. After this, the Examiner issued another non-final rejection on October 7, 2005. In this non-final rejection, the Examiner attempted to take Official Notice. Specifically, the Examiner stated:

GolfAgent does not explicitly disclose that the multiple tee times at a *plurality of golf courses* are generated on a single web page. However, the Examiner takes Official Notice that it is old and well-known to display multiple reservations times from a plurality of entities on a single page. For example, in the travel industry, when one is shopping for an airline reservation and/or hotel reservation or a vehicle rental reservation, the user generally enters the dates that the reservations are needed and a webpage is generated and displayed to the user listing multiple airline carriers

and/or hotels from different chains and/or vehicles available for rent at various companies that are available on those dates.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the golf reservation method of GolfAgent which is used to book tee times at a wide range of golf courses as a matter of convenience for the user so that the user can view all the courses in that area having available tee times on the dates you require.

Appellant then instituted this appeal. In the Appeal Brief, Appellant challenged and traversed this attempt to take Official Notice. Additionally, Appellant again provided the objective evidence of nonobviousness that was previously provided on February 17, 2005, and further noted that the “record is replete with objective evidence of nonobviousness *which has not been considered* or given due weight” (emphasis added, page 24 of Appeal Brief). In the Examiner’s Answer, the Examiner addressed Appellant’s objective evidence of nonobviousness for the first time. That is, the Examiner did not address this evidence in the subsequent Office action after it was submitted as the Examiner admits (pages 22-23 of the Examiner’s Answer):

This objective evidence of nonobviousness is being considered by the Examiner for the first time in the Examiner’s Answer. Appellant originally submitted the exhibits on February 17, 2005, wherein the appellant submitted both 131 and 132 affidavits/declarations The next Office Action mailed on March 25, 2005, was a non-final action [in which the arguments were not addressed because of a new rejection].

In response to the Examiner addressing Appellant’s objective evidence of nonobviousness for the first time on appeal, Appellant was forced to file this Petition and a Reply Brief.

Also, the Examiner appears not to have obtained the permission of the Technical Center Director to add new grounds of rejection. On July 19, 2006, the undersigned

spoke with Pamela Allen, assistant to Technical Center Director Wynn Wood Coggins, who could not confirm that the Examiner sought permission to add a new ground of rejection. Upon request to speak to the Technical Center Director, she instead referred the undersigned to the Examiner's Supervisor John Weiss, who also was not able to confirm that the Examiner had obtained permission from the Technical Center Director to add a new ground of rejection. On July 21, 2006, the undersigned spoke directly to the Examiner, who asked what the new ground or rejection or argument was, clearly indicating that she did not seek the Technical Center Director's approval to enter a new ground of rejection, argument or reference. Moreover, in the Examiner's Answer, there is no mention of obtaining the Technical Center Director's permission to add a new ground of rejection in the form of arguing that the specification does not support the Claims as recited (essentially a rejection under 35 U.S.C. § 112, First or Second Paragraph, although not explicitly labeled as such). Similarly, although the Examiner admitted that the objective evidence of nonobviousness was being considered for the first time in the Examiner's Answer, there is no explicit identification of it as a new ground of rejection. And finally, since the initial taking of Official Notice on October 7, 2005 was defective *ab initio*, the taking of Official Notice in the Examiner's Answer also constitutes a new ground of rejection not labeled as such.

3. Requirements for a New Ground of Rejection in an Examiner's Answer

Although new grounds of rejection in an Examiner's Answer are permissible, they are envisioned to be rare. For an Examiner to enter a new ground of rejection, the Examiner must satisfy two requirements. *See* MPEP § 1207.03. First, the Examiner must obtain approval by a Technology Center Director or designee to enter a new ground of rejection. *Id.* Second, any new ground of rejection must be "prominently identified in the 'Grounds of Rejection to be Reviewed on Appeal' section and the 'Grounds of Rejection' section of the answer." *Id.* Moreover, section 1207.03 of the MPEP also states that "if an appellant has clearly set forth an argument in a previous reply during prosecution of the application and the examiner has failed to address that argument, the examiner would not be permitted to add a new ground of rejection in the examiner's answer to respond to that argument but would be permitted to reopen prosecution, if

appropriate.” Given the lengthy period of prosecution and ample opportunity for the Examiner to have raised such a new ground or to respond to Appellant’s arguments and evidence during prosecution, it is submitted that it would be inappropriate to permit reopening of prosecution of this application to provide the Examiner yet another opportunity to argue new grounds and further delay rightful issuance of a patent on this application. The appropriate remedy is, instead, to have the Examiner’s new grounds of rejection stricken from the record, to regard the objective evidence of nonobviousness as unrefuted and therefore conclusively proven, and to decide the Appeal on this basis.

4. Examiner’s Failure to Properly Consider the Objective Evidence of Nonobviousness

As noted above, the Examiner has failed to comply with the requirements for properly entering a new ground of rejection in an Examiner’s Answer. First, it appears that the Examiner failed to obtain the approval necessary for entering such new grounds of rejection in failing to properly consider the objective evidence of nonobviousness. Furthermore, the Examiner failed to identify the new grounds of rejection as such in the Examiner’s Answer. Therefore, the Examiner failed to comply with the requirements for entering a new ground of rejection in the Examiner’s Answer, and, thus, the entry was improper. Moreover, the Examiner had sufficient opportunity to address Appellant’s objective evidence of nonobviousness in the subsequent Office action after it was submitted, but this she failed to do.

Section 716.01 of the MPEP states that “[e]vidence traversing rejections, when timely presented, must be considered[,] acknowledged and commented upon by the examiner in the next succeeding action.” Additionally, section 1207.03 of the MPEP specifically states “if an appellant has clearly set forth an argument in a previous reply during prosecution of the application and the examiner has failed to address that argument, the examiner would not be permitted to add a new ground of rejection in the examiner’s answer to respond to that argument but would be permitted to reopen prosecution, if appropriate.” This is precisely what happened in this case. After having sufficient opportunity to address the merit of Appellant’s objective evidence of

nonobviousness and failing to do so, the Examiner now casually disregards the evidence, which constitutes a new ground of rejection.

As noted, on February 17, 2005, Appellant provided substantial, objective evidence of nonobviousness to be considered with the new claims also submitted at that time. However, in the subsequent Office action dated March 24, 2005, the Examiner failed to address the merit of Appellant's evidence. Appellant then responded to the Office action dated March 24, 2005, in the communication dated June 24, 2005, but the Examiner issued another non-final rejection on October 7, 2005. Appellant then instituted this appeal. Appellant again enumerated the objective evidence of nonobviousness previously submitted on February 17, 2005, in the Appeal Brief. In the Appeal Brief, Appellant also acknowledged that the "record is replete with objective evidence of nonobviousness *which has not been considered* or given due weight" (emphasis added, page 24 of Appeal Brief). That is, Appellant duly noted that the Examiner failed to address the merit of the evidence in the subsequent Office action after it was submitted. Instead, the Examiner addressed this evidence for the first time in the Examiner's Answer (pages 22-23 of the Examiner's Answer):

This objective evidence of nonobviousness is being considered by the Examiner for the first time in the Examiner's Answer. Appellant originally submitted the exhibits on February 17, 2005, wherein the appellant submitted both 131 and 132 affidavits/declarations The next Office Action mailed on March 25, 2005, was a non-final action [in which the arguments were not addressed because of a new rejection.

Because the Examiner failed to address the objective evidence of nonobviousness in the subsequent Office action after it was submitted, the Examiner is not now permitted to consider this evidence in the Examiner's Answer.

In addressing Appellant's objective evidence of nonobviousness for the first time on appeal, the Examiner has placed Appellant at a procedural disadvantage. This is similar to what occurred in *Ex Parte Movva*. See generally, *Ex Parte Movva*, 1993 Pat. App. LEXIS 16, 31 USPQ2d 027, 1028 (Bd. Pat. App. & Interf. 1993). In *Ex Parte*

Movva, the examiner cited four new references in the Examiner's Answer without officially entering a new ground of rejection. *Id.* Because the examiner's actions placed the appellants at a procedural disadvantage, the Board of Patent Appeals and Interferences ignored the new references in reviewing the examiner's rejections:

Since a new ground of rejection was not made, appellants were not entitled as a matter of right to respond to this new evidence of obviousness by way of amendment and/or evidence. Rather, appellants were limited to presenting argument by way of a Reply Brief. The procedural disadvantage in which appellants were placed by the examiner's action is apparent. Accordingly, we have not considered the four references in determining the correctness of the rejection before us in this appeal. If in further prosecution of this subject matter, the examiner continues to find these references to be relevant evidence of obviousness . . . , a proper rejection should be made.

Likewise in this case, the Examiner's actions have placed Appellant at a procedural disadvantage. Because the Examiner failed to address the objective evidence of nonobviousness in the subsequent Office action after they were submitted, Appellant is forced to respond with this Petition.

5. Alleged Lack of Support in the Disclosure

On pages 11-12 of the Examiner's Answer, the Examiner asserts that Appellant defines the invention in a manner not disclosed in Appellant's original disclosure. Specifically, the Examiner states:

Appellant has provided no disclosure stating that the golfer need not "drill down" into specific web pages for a golf course, nor that the golfer need not be redirected to the golf course's website. At most, the appellant discloses that the golfer is not required to undertake an elaborate database query to "zero in" on a desired time. The Examiner asserts that there is no

disclosure stating a golfer need not “drill down” into the specific web pages

The Examiner’s assertions are incorrect. Through Appellant’s statements, Appellant was characterizing the alleged prior art provided by the Examiner, and illustrating limitations that do not restrict the present invention (pages, 14, 22, 24, and 25 of Appeal Brief). In other words, Appellant was describing limitations that the present invention does not have, i.e., describing what the present invention is not. Therefore, Appellant was not required to include information in the disclosure of characteristics that do not define the present invention, but, rather, are limitations of the alleged prior art.

Moreover, this is in essence a rejection under 35 U.S.C. § 112, First or Second Paragraphs under the guise of an obviousness rejection. And as such, not only are the Examiner’s assertions incorrect, but they also constitute a new ground of rejection. Again, with respect to this new ground of rejection, the Examiner again failed to comply with the requirements for putting forth such a new ground. Specifically, it appears as though the Examiner failed to obtain approval by a Technology Center Director or designee to enter a new ground of rejection. And clearly, the Examiner failed to prominently identify the new ground of rejection in the “Grounds of Rejection to be Reviewed on Appeal” section and the “Grounds of Rejection” section of the answer. *See* MPEP § 1207.03.

6. The Taking of Official Notice

Official Notice unsupported by documentary evidence should only be taken if the facts asserted to be well-known “are capable of instant and unquestionable demonstration as being well-known.” *See e.g.*, MPEP § 2144.03; *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). Therefore, it is *not* appropriate for an examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of such demonstration. Unfortunately, such was the case

with this application. On October 7, 2005, the Examiner attempted to take Official Notice of assertions *not* capable of instant and unquestionable demonstration as being well-known:

GolfAgent does not explicitly disclose that the multiple tee times at a *plurality of golf courses* are generated on a single web page. However, the Examiner takes Official Notice that it is old and well-known to display multiple reservations times from a plurality of entities on a single page. For example, in the travel industry, when one is shopping for an airline reservation and/or hotel reservation or a vehicle rental reservation, the user generally enters the dates that the reservations are needed and a webpage is generated and displayed to the user listing multiple airline carriers and/or hotels from different chains and/or vehicles available for rent at various companies that are available on those dates.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the golf reservation method of GolfAgent which is used to book tee times at a wide range of golf courses as a matter of convenience for the user so that the user can view all the courses in that area having available tee times on the dates you require.

In short, the Examiner relied on her own understanding of what would be basic knowledge in the art in an attempt to take Official Notice. That is, the Examiner failed to point to some concrete evidence in the record to support her assertions. Rather, the Examiner generally alleged that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the golf reservation method of GolfAgent . . . as a matter of convenience for the user” Since this assertion is not capable of instant and unquestionable demonstration as being well-known, the taking of Official Notice was defective *ab initio*. Therefore, Appellant contends that because the Examiner’s attempt to take Official Notice was defective *ab initio*, the subsequent taking of Official Notice in the Examiner’s Answer and citation of additional documents alleged

to support the proposition for which Official Notice was taken constitutes a new ground of rejection. And as such, the Examiner failed comply with the requirements for entering such a new ground by failing to obtain approval by a Technology Center Director or designee to enter this new ground of rejection and failing to prominently identify the new ground of rejection in the “Grounds of Rejection to be Reviewed on Appeal” section and the “Grounds of Rejection” section of the answer.

Action Requested

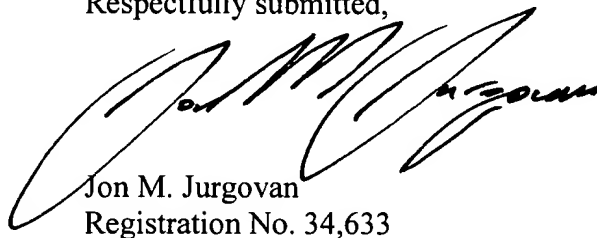
Because the Examiner failed to satisfy the requirements for entering a new ground of rejection in each of the above instances and further failed to seasonably address the merit of Appellant’s objective evidence of nonobviousness, Appellant respectfully submits that the proper remedy is to have the Examiner’s new grounds of rejection identified as such, stricken from the record, to regard the objective evidence of nonobviousness as unrefuted and therefore conclusively proven, and to decide the Appeal on this basis.

CONCLUSION

For the foregoing reasons, Appellant respectfully requests to have the Examiner's new grounds of rejection identified as such, stricken from the record, to regard the objective evidence of nonobviousness as unrefuted and therefore conclusively proven, and to decide the Appeal on this basis.

Please charge any fee deficiency and credit any overpayment in connection with the filing of this Petition to our Deposit Account No. 16-0605.

Respectfully submitted,



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